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## No Room for Cheers: Schizophrenic Application in the Realm of Right of Publicity Protection

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## Comments

### NO ROOM FOR CHEERS: SCHIZOPHRENIC APPLICATION IN THE REALM OF RIGHT OF PUBLICITY PROTECTION

Did one look at what one saw  
Or did one see what one looked at?

— Hart Crane<sup>1</sup>

#### I. INTRODUCTION

Andy Warhol's words ring immortal: "In the future everyone will be world-famous for fifteen minutes."<sup>2</sup> With the advent of a colossal film industry that consists of movie production agencies, actors and actresses, as well as merchandising moguls and distributors of commercial products for mass consumption, the legal world has become entangled in a battle over celebrity rights and the level of protection afforded by the courts.<sup>3</sup> For more than fifty years, contradiction and confusion have defined the right of publicity in the United States.<sup>4</sup> The right of publicity has developed in re-

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1. HART CRANE, HIEROGLYPHIC, COMPLETE POEMS OF HART CRANE 189 (Liveright Marc Simon ed., 1989).

2. Andy Warhol, *quoted in* J. BARTLETT, FAMILIAR QUOTATIONS 908 (15th ed. 1980).

3. *See* Haelan Labs., Inc. v. Topps Chewing Gum, Inc., 202 F.2d 866, 868 (2d Cir. 1953). Judge Frank reasoned:

For it is common knowledge that many prominent persons . . . far from having their feelings bruised through public exposure of their likenesses, would feel sorely deprived if they no longer received money for authorizing advertisements, popularizing their countenances, displayed in newspapers, magazines, busses [sic], trains and subways. This right of publicity would usually yield them no money unless it could be made the subject of an exclusive grant which barred any other advertiser from using their pictures.

*Id.* at 868.

4. In an effort to distinguish the right of exclusive control over the commercial exploitation of personality from the "right of privacy," the Second Circuit coined the phrase "right of publicity" in 1953 in *Haelan Labs*, 202 F.2d at 868. Most commentators and courts agree that the decision in *Haelan* marks the emergence of the right of publicity. *See, e.g.,* Sheldon W. Halpern, *The Right of Publicity: Maturation of an Independent Right Protecting the Associative Value of Personality*, 46 HASTINGS L.J. 853, 854 (1995) (stating that "[t]he right of publicity as currently understood was the product of the determination of the Second Circuit in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*"); H. Lee Hetherington, *Direct Commercial Exploitation of Identity: A New Age for the Right of Publicity*, 17 COLUM.-VLA J.L. & ARTS 1, 2 (1992) (stating that "[t]he court suggested the label, 'right of publicity,' and by so

sponse to the semiotic weight given to the commercialization of the associative value of celebrity.<sup>5</sup> Courts have said that the right of publicity has been developed in order to protect the commercial interest of celebrities in their identities.<sup>6</sup> Unauthorized commercial exploitation is the cynosure of the debate that surrounds the elusive area of celebrity rights.<sup>7</sup> Critics of this right, such as Judge Kozinski, argue that monopolies on celebrity fame stifle the creation of future celebrity images by preventing the use of old images to inspire those that are new.<sup>8</sup>

In direct contrast to the right of privacy, which has fallen privy to a bevy of skeptics and critics, courts and commentators have

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doing, provided the legal theory that would help empower celebrities in the emerging economic sphere being created by the entertainment, media and advertising industries.”).

5. See, e.g., Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 128-29 (1993). Madow states:

The fact that celebrities haul so much semiotic freight in our culture has a number of important consequences. One such consequence—one with which American law, in my view, has been unduly impressed—is that star images enhance the commercial value of commodities with which they are associated. Most obviously, celebrity sells cultural commodities: movies, records, videos, and so on. Since the early years of this century, when the Hollywood “star system” first took hold, celebrity has been a vital factor of production in what Adorno and Horkheimer christened the “culture industry.” Beyond this, however, we can distinguish three central ways in which celebrity generates economic value. First, there is intense demand for information about the lives and doings of celebrities—for news stories, gossip items, biographies, interviews, docudramas. Second, there is a large and increasingly lucrative market for merchandise (T-shirts, posters, greeting cards, buttons, party favors, coffee mugs, school notebooks, dolls, and so on) bearing the names, faces, or other identifying characteristics of celebrities, living and dead. Third, as contemporary advertising practice amply attests, celebrity enhances the marketability of a wide array of collateral products and services.

*Id.* (citations omitted).

6. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) (stating right of celebrity is mechanism to protect against commercial exploitation of identity); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 824-25 (9th Cir. 1974) (noting mental and economic injury to celebrity from appropriation of identity with commercial value); *Henley v. Dillard Dep’t Stores*, 46 F. Supp. 2d 587, 590 (N.D. Tex. 1999) (examining purpose of right of publicity); see also Barbara A. Burnett, *The Property Right of Publicity and the First Amendment: Popular Culture and the Commercial Persona*, 3 HOFSTRA PROP. L.J. 171, 173 (1990) (discussing right of publicity).

7. For a further discussion of commercial exploitation as being the cynosure of current debate, see *infra* notes 23-31 and accompanying text.

8. See *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512 (9th Cir. 1993) (Kozinski, J., dissenting) (denying petition for rehearing). Judge Kozinski argued vehemently against the scope of protection that the right of publicity was attaining and stated: “[s]omething very dangerous is going on here.” *Id.* at 1513. “We give authors certain exclusive rights, but in exchange we get a richer public domain. The majority ignores this wise teaching, and all of us are poorer for it.” *Id.* at 1517.

more readily embraced the right of publicity.<sup>9</sup> The right of publicity is defined as a right that “protects against commercial misappropriation of one’s name, likeness, or identity.”<sup>10</sup> A dense history of complex cases adumbrates the need for a federal statute that provides guidance to the courts in order to preclude confusion and dispute over a host of issues relating to celebrity and the associated images seeking protection.<sup>11</sup> Questions have emerged as to whether publicity is a species evolving from a property right or a personal privacy interest.<sup>12</sup> Yet another bifurcating path arises with the inquiry into whether right of publicity weaves its way into the old torts of misappropriation and unfair competition.<sup>13</sup>

This Comment argues that there is a need for a federal statute or a definitive perspective within our nation’s judicial system with regard to the right of publicity. A statute would provide guidance for the courts as they venture into a contradictory and confused area that results in an inconsistent and unpredictable application of the law.<sup>14</sup> Part II provides an overview of publicity rights within the United States by beginning with a definition of celebrity<sup>15</sup> and the justifications for affording celebrities right of publicity protection.<sup>16</sup> This section also examines the evolution of the right of publicity and its distinction from the privacy doctrine.<sup>17</sup> Part III of this Com-

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9. See Halpern, *supra* note 4, at 853 (discussing right in value of identity). Halpern concludes:

The *Haelan* opinion’s recognition of a proprietary interest in personality and the analytic work done over four decades adumbrate a right that is predicated on significant societal interests and concerns. It is not happenstance that the right of publicity has come to be articulated in the *Restatement of the Law of Unfair Competition*. There is, at bottom, recognition of the fact that there is something wrong, a manifest “unfairness,” when one person seeks to trade on the personality of another.

*Id.* at 873.

10. Balaram Gupta, *Names and Logos: Protection Under Intellectual Property Laws and Consequences*, 2 SPORTS LAW J. 245, 264 (1995).

11. For a complete discussion of the need for a federal statute, see *infra* notes 147-66 and accompanying text.

12. See *Reeves v. United Artists*, 572 F. Supp. 1231, 1232-33 (N.D. Ohio 1983), *aff’d*, 765 F.2d 79 (6th Cir. 1985); *Lugosi v. Universal Pictures*, 603 P.2d 425, 429 (Cal. 1979).

13. See Richard Ausness, *The Right of Publicity: A “Haystack in a Hurricane,”* 55 TEMP. L.Q. 977, 983-87 (1982).

14. For a further discussion of the need for a federal statute, see *infra* notes 147-66 and accompanying text.

15. For a further discussion of what defines a celebrity, see *infra* notes 24-27 and accompanying text.

16. For a further discussion of the justifications for the right of publicity, see *infra* notes 32-37 and accompanying text.

17. For a further discussion of the evolution of the right of publicity doctrine, see *infra* notes 61-80 and accompanying text.

ment examines the right of publicity as affected by federal copyright law<sup>18</sup> and First Amendment concerns.<sup>19</sup> Part IV presents the Ninth Circuit's approach in *Wendt v. Host International, Inc.*<sup>20</sup> as representative of the expansive approach to the right of publicity.<sup>21</sup> Part V proposes the need for a definitive perspective in the form of a federal statute in order to bring uniformity and predictability to this elusive area of law.<sup>22</sup>

## II. PUBLICITY RIGHTS IN THE UNITED STATES

The right of publicity protects a celebrity's right against exploitation of his or her identity.<sup>23</sup> This protection begs the question - who is a celebrity? In *Martin Luther King, Jr., Center for Social Change v. American Heritage Products, Inc.*,<sup>24</sup> the court concluded that the term "celebrity" should be interpreted to encompass more than the traditional categories of movie stars, sports players and rock and roll stars.<sup>25</sup> An argument exists that defining celebrity is an exercise rendered unnecessary if the right of publicity is examined in terms

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18. For a further discussion of the federal copyright act as being utilized to strike an adequate balance between public and private interests, see *infra* notes 81-87 and accompanying text.

19. For a further discussion of First Amendment concerns, see *infra* notes 115-31 and accompanying text.

20. 197 F.3d 1284 (9th Cir. 1999).

21. For a further discussion of the Ninth Circuit's expansive approach to the right of publicity, see *infra* notes 132-46 and accompanying text.

22. For a further discussion of the need for a definitive perspective, see *infra* notes 147-66 and accompanying text.

23. See J. Thomas McCarthy, *Melville B. Nimmer and the Right of Publicity: A Tribute*, 34 UCLA L. REV. 1703, 1704 (1987).

24. 694 F.2d 674 (11th Cir. 1983).

25. See *id.* at 683 (stating "[a] well known minister may avoid exploiting his prominence during life . . . [and] is [further] entitled to have his image protected against exploitation after death . . ."); see also Hetherington, *supra* note 4, at 21. Hetherington states:

This interpretation mirrors a societal reality which makes Andy Warhol's assertion that "everybody will be world famous for 15 minutes" more of a truism than a prophecy. A quick survey of morning television, airport magazine racks and book store shelves will reveal an unlikely assortment of celebrities which include corporate officers, law professors and just about every line of work prefixed by "ex"—football coaches, test pilots, Congressmen—who qualify for celebrity status by virtue of their second careers as television pitchmen. Even the completely anonymous have been catapulted onto the center stage of pop culture thanks to the willingness of an advertising executive to take a chance on an unknown. All of this bolsters the view that anyone whose identity commands value in the commercial marketplace should qualify for protection under the "direct commercial exploitation of identity" test.

*Id.* at 45-46.

of a "direct commercial exploitation of identity test."<sup>26</sup> This test provides protection to anyone whose identity has been exploited for commercial gain.<sup>27</sup>

The increasing focus on celebrities' rights is spawned by the fascination of popular culture with the consumption of the entertainment industry.<sup>28</sup> As harbingers of tremendous revenue, celebrities' pecuniary interests in monitoring the authorized and unauthorized use of their names, images, likenesses, and other indicia of identity become particularly important.<sup>29</sup> Celebrities often generate colossal revenues by marketing techniques that include endorsement of products, special appearances and merchandising products that bear their defining characteristics.<sup>30</sup> Accordingly, an assumption exists that celebrities have a strong interest in protecting their identity when the upshot of their doing so involves reaping huge profits and maintaining their public reputation.<sup>31</sup>

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26. See Hetherington, *supra* note 4, at 46. Under this line of reasoning, anyone whose identity has been directly exploited commercially and misappropriated gains entrance into the echelon of celebrity for right of publicity purposes. See *id.* Thus, the only remaining question is proof of damages and/or irreparable harm warranting equitable relief. See *id.* In evaluating whether an identity has been directly exploited commercially and misappropriated, Hetherington argues that industry practice and ethical codes of conduct become relevant inquiries in assessing proof of damages. See *id.* at 48. She further argues that inferences may be drawn based upon an examination of facts and surrounding circumstances that include, but are not limited to, "internal business documents, meeting minutes and conduct consistent with an intent to misappropriate elements of a celebrity's identity for direct, commercial gain." *Id.*; see also *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988) (holding, without defining celebrity, that "defendants here for their own profit in selling their product did appropriate part of [Midler's] identity"); *Lombardo v. Doyle Dane & Bernach*, 396 N.Y.S.2d 661 (N.Y. App. Div. 1977) (Titone and Suizzi, JJ., concurring).

27. See Hetherington, *supra* note 4, at 46.

28. Theodore Adorno & Max Horkheimer, *The Culture Industry: Enlightenment as Mass Deception*, in *MASS COMMUNICATION AND SOCIETY* 349 (James Curran et al. eds., 1977).

29. See generally Melville B. Nimmer, *The Right of Publicity*, 19 *LAW & CONTEMP. PROBS.* 203, 218-23 (1954) (discussing early cases regarding right of publicity).

30. See Larry Rohter, *Pop-Music Fashion Becomes a Sales Hit*, *N.Y. TIMES*, Jan. 8, 1991, at D1. Rohter reports that annual revenues derived from music merchandising is over a half-billion dollar industry. See *id.* Music merchandising includes the sale of paraphernalia bearing the names, faces or logos of musical groups and popular performers. See *id.*

31. Some courts have expanded right of publicity protection to include many forms of publicity promotions. See, e.g., *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1399 (9th Cir. 1992) (recognizing viable right of publicity claim where robot used in advertisement); *Midler v. Ford Motor Co.*, 849 F.2d 460, 463 (9th Cir. 1988) (permitting claim of voice misappropriation); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 732 (S.D.N.Y. 1978) (enjoining distribution of magazine containing nude portrayal of plaintiff).

Several arguments are propounded in support of the right of publicity.<sup>32</sup> First, proponents argue that the artist who achieves celebrity status is entitled to property rights associated with his or her identity because of the labor expended to attain celebrity status.<sup>33</sup> Additionally, offering protection for this right provides artists and actors with a significant incentive to spend sufficient time and resources for the development of skills necessary to achieve public recognition.<sup>34</sup> Second, unjust enrichment of those who have not contributed to the publicity value of the celebrity's image is precluded.<sup>35</sup> Third, celebrities are given the opportunity to protect the market value of their publicity when self-interested entrepreneurs are prevented from exploiting publicity value.<sup>36</sup> Lastly, right of publicity proponents propose that the "twilight zone" of copy-right law, which fails to distinguish between the character itself and the character's features and characteristics portrayed, is adequately addressed by the right of publicity.<sup>37</sup>

The substantive criticism against offering right of publicity protection is rooted in the conception that right of publicity stifles cultural dialogue<sup>38</sup> by furthering celebrities' capitalization on their

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32. See Sudakshina Sen, *Fluency of the Flesh: Perils of an Expanding Right of Publicity*, 59 ALB. L. REV. 739, 739-40 (1995) (discussing several arguments raised that justify right of publicity); Michael Madow, *supra* note 5, at 167 (suggesting right of publicity finds origins in frustration over right of privacy).

33. See Madow, *supra* note 5, at 179-96 (discussing property right associated with celebrity status).

34. See *Lugosi v. Universal Pictures*, 603 P.2d 425, 441 (Cal. 1979) (Bird, C.J., dissenting).

35. See *id.* at 444-45 (Bird, C.J., dissenting) (propounding view that protecting one's likeness while portraying character may be of paramount importance); see also Kevin S. Marks, *An Assessment of the Copyright Model in Right of Publicity Cases*, 70 CAL. L. REV. 786, 789 n.13 (1982).

36. See Marks, *supra* note 35, at 789 n.13.

37. See *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221 (2d Cir. 1978); *Lerman v. Chuckeleberry Pub., Inc.*, 521 F. Supp. 228, 232 (S.D.N.Y. 1981); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728-29 (S.D.N.Y. 1978); see also Kenneth E. Spahn, *The Right of Publicity: A Matter of Privacy, Property, or Public Domain?*, 19 NOVA L. REV. 1013, 1018 (1995).

38. See Madow, *supra* note 5, at 239 (stating that right of publicity constricts "[O]ur cultural common, [which should be] freely available for use in the creation of new cultural meanings and social identities, as well as new economic values.").

fame.<sup>39</sup> Eighth Circuit courts, however, continue their recognition of such protection.<sup>40</sup>

The right of publicity was formulated as a solution to the widening gyre of problems associated with celebrities as they attempted to assert the right of privacy and the tort of appropriation in order to protect the pecuniary interests in their images.<sup>41</sup> Pecuniary interests contradict celebrities' personal interests in preventing unauthorized commercial use of names or likeness that causes embarrassment or humiliation.<sup>42</sup>

William Prosser's seminal article on the right of privacy divides the right into four different categories of tort: (1) intrusion; (2) appropriation;<sup>43</sup> (3) disclosure; and (4) false light, of which the

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39. See, e.g., William M. Heberer III, Comment, *The Overprotection of Celebrity: A Comment on White v. Samsung Electronics America, Inc.*, 22 HOFSTRA L. REV. 729, 750 (1994); Todd J. Rahimi, Comment, *The Power to Control Identity: Limiting A Celebrity's Right to Publicity*, 35 SANTA CLARA L. REV. 725, 747 (1995) (noting argument that right of publicity protection will result in what Judge Kozinski calls "impoverishing of the public domain"); Linda J. Stack, Note, *White v. Samsung Electronics America, Inc.'s Expansion of the Right of Publicity: Enriching Celebrities at the Expense of Free Speech*, 89 NW. U. L. REV. 1189, 1213-14 (1995); Fred M. Weiler, Note, *The Right of Publicity Gone Wrong: A Case For Privileged Appropriation of Identity*, 13 CARDOZO ARTS & ENT. L.J. 223, 243 (1994).

40. See, e.g., *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1206 (8th Cir. 1969) (recognizing celebrity images as having property value).

41. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996) (noting that right of publicity remains business right to control use of one's identity in commerce rather than personal right to be left alone); WILLIAM PROSSER, *LAW OF TORTS* § 117 (4th ed. 1971) (right of publicity differs from law of privacy from which it finds its origins).

42. See Nimmer, *supra* note 29, at 207-08.

43. See generally Richard S. Robinson, *Preemption, the Right of Publicity, and a New Federal Statute*, 16 CARDOZO ARTS & ENT. L.J. 183, 188 (1990). Robinson compares publicity rights to the tort of appropriation as such:

An action for the privacy tort of appropriation can be brought where a defendant makes unauthorized use of a plaintiff's identity for commercial purpose or private gain. In this respect, appropriation and the right of publicity are identical. Two key differences, however, weaken appropriation's usefulness as a publicity rights defense. According to William Prosser, the privacy tort of appropriation requires both the unauthorized use of the plaintiff's identity and injury to the plaintiff's dignity or self esteem. As seen in *Haelan*, where the harm is strictly economic, the absence of emotional or physical distress makes it impossible to prevail on an appropriation claim.

*Id.* (citations omitted). Robinson also examines a second critical difference found in appropriation's function as a branch of privacy law by delineating personal rights as privacy rights, not property rights. See *id.* The fundamental difference between personal rights and property rights is that personal rights are not freely alienable, transferable or descendible. See *id.* at 189.



right of publicity is mentioned in the second tort of appropriation.<sup>44</sup>

### A. The Realm of Protection

First coined in *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*,<sup>45</sup> right of publicity was recognized in addition to and independent of right of privacy.<sup>46</sup> Haelan contracted with a number of professional baseball players to have the exclusive right to use their images on baseball cards Haelan produced.<sup>47</sup> The players agreed to refuse any other manufacturer a similar right.<sup>48</sup> Despite this agreement, Topps Chewing Gum, Inc., a rival of Haelan in the baseball card and chewing gum industry, deliberately induced the baseball players to authorize the use of their photographs for their own cards in contravention of Haelan's contracts.<sup>49</sup> Haelan could not preclude Topps from using the players' images on privacy grounds because the players did not grant Haelan the right to sue on their behalf and could not show that they had suffered mental distress.<sup>50</sup> Nevertheless, the court found for Haelan on the grounds that "in addition to and independent of that right of privacy . . . a man has a right in the publicity value of his photograph."<sup>51</sup> In effect, when

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44. See RESTATEMENT (SECOND) OF TORTS §§ 6521, 652A-652I cmt. a (1977); William Prosser, *Privacy*, 48 CAL. L. REV. 383, 398-401 (1960) (discussing false light in public eye as form of invasion of privacy). Prosser's wholesale discussion of his right of privacy framework into the *Restatement (Second) of Torts* instigated discussion of the creation of a separate right of publicity, which culminated in the inclusion of the right of publicity in the American Law Institute's *Restatement (Third) of the Law of Unfair Competition*. See RESTATEMENT (SECOND) OF TORTS §§ 652A-652I.

45. 202 F.2d 866, 867-68 (2d Cir. 1953). Judge Jerome N. Frank said: We think that, in addition to and independent of that right of privacy (which in New York derives from statute), a man has a right in the publicity value of his photograph, i.e., the right to grant the exclusive privilege of publishing his picture, and that such a grant may validly be made "in gross," i.e., without an accompanying transfer of a business or of anything else . . . . This right might be called a "right of publicity."

*Id.* at 868.

Earlier case law similarly refused to recognize such right. See, e.g., *Roberson v. Rochester Folding-Box Co.*, 64 N.E. 442, 447-48 (N.Y. 1902) (declining to recognize woman's right against unauthorized use of her portrait in campaign to promote flour sales).

46. See *Haelan Labs.*, 202 F.2d at 868.

47. See *id.* at 867.

48. See *id.*

49. See *id.*

50. See *id.* at 868.

51. *Haelan Labs.*, 202 F.2d at 868. The court further stated that the publicity right of the photograph, i.e., the right to grant exclusive privilege to publish his picture, could be validly granted "in gross." See *id.*

Haelan contracted with the players for the exclusive right to publish their images, Topps was precluded from doing likewise.<sup>52</sup>

Courts appear reluctant to hold explicitly that the right of publicity may extend to the protection of characters, though numerous decisions have granted an actor protection from exploitation of his or her character.<sup>53</sup> Additionally, courts are reluctant to grant a celebrity a property interest in a character to which the actor has no legal rights.<sup>54</sup> Protection of characters, rather, is evaluated at the point when the character's protection becomes most compelling and in terms of whether: (1) the actor portrays himself or herself as

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52. *See id.* at 868-69.

53. *See, e.g.,* Carson v. Here's Johnny Portable Toilets, 698 F.2d 831, 842 (6th Cir. 1983) (stating that characters should receive right of publicity protection); Price v. Worldvision Enters., Inc., 455 F. Supp. 252, 257-58 (S.D.N.Y. 1978) (discussing greater likelihood that right of publicity protection be afforded to fictional characters created by actors). In *Price*, the court held the defendant's use of the characters violated a previously issued injunction that prohibited the defendants from impersonating Laurel and Hardy's "physical likeness of appearances, costumes and mannerisms, and/or the simulation of their voices, for advertising or commercial purposes, including their use in, or in connection with . . . the production of animated cartoons or motion pictures . . . ." *Price*, 455 F. Supp. at 257-58; *see also* Rogers v. Grimaldi and MGM/UA Entm't Co., 695 F. Supp. 112, 124 (S.D.N.Y. 1988) (stating that commercial exploitation of character would justify right of publicity protection); Allen v. Nat'l Video, Inc., 610 F. Supp. 612, 632 (S.D.N.Y. 1985) (recognizing celebrity may be exploited by his character and extending right of publicity protection to characters identifying actors who create and portray them).

In *Rogers*, the Southern District of New York addressed whether Ginger Rogers' right of publicity was violated by defendants' distribution and production of a film in which the characters were dancers imitating Fred Astaire and Ginger Rogers. *See Rogers*, 695 F. Supp. at 113. The characters called themselves "Fred and Ginger." *See id.* at 114. Rogers substantive claim was that the film, "Frederico Fellini's 'Ginger and Fred,'" misappropriated her public personality, which she developed via elegant ballroom dancing in some seventy-three motion picture films with her most renowned role as Astaire's partner. *See id.* at 113-14. Despite the fact that the court did not reject the contention that Roger's right of publicity could be violated through appropriation of her elegant ballroom dancing character, the court held that because the film did not use Rogers' name for commercial purpose, her right of publicity claim should be dismissed. *See id.* at 124. Although the court did not grant Rogers right of publicity protection, the opinion stands for the viability of an actor's right of publicity claim against a defendant who commercially exploits a character based on an actor. *See id.*

54. *See, e.g.,* Baltimore Orioles v. Major League Baseball Players, 805 F.2d 663, 679 (7th Cir. 1986) (holding that right of publicity actions cannot be brought against unauthorized uses of copyrighted works, as actors do not own any rights in these works effecting preemption by Federal Copyright Act); Lugosi v. Universal Pictures, 603 P.2d 425, 431-35 (Cal. 1979) (same); Fleet v. CBS, Inc., 50 Cal. App. 4th 1911, 1919-25 (1996) (same).

a character;<sup>55</sup> (2) the actor creates the character;<sup>56</sup> (3) the character is based on the actor;<sup>57</sup> (4) the actor plays a character with the same name, but with fictional elements;<sup>58</sup> (5) the actor plays a char-

55. This situation presents the strongest argument for right of publicity's extension for the protection of character misappropriation. A character shares an actor's identity when an actor plays himself or herself as a character. An illustration of when an actor plays himself or herself in a role is that of a game or talk show host. In the aforementioned scenario, the character and actor share the same name and are not obligated to a scripted dialogue. Furthermore, the character and actor share a common personality, mannerisms and speech patterns that may be lacking when an actor plays the role of a character bound to the limitations of a script.

56. See *Lugosi*, 603 P.2d at 425. Justice Mosk stated in his concurrence: I do not suggest that an actor can never retain a proprietary interest in a characterization. An original creation of a fictional figure played exclusively by its creator may well be protectible. Thus, Groucho Marx just being Groucho Marx, with his moustache, cigar, slouch and leer, cannot be exploited by others. Red Skelton's variety of self-devised roles would appear to be protectible, as would the unique personal creations of Abbott and Costello, Laurel and Hardy and others of that genre.

*Id.* at 432 (Mosk, J., concurring) (citations omitted). In *Lugosi*, the descendants of Bela Lugosi sought to recover profits made by Universal Pictures' efforts to commercially license the Count Dracula character. See *id.* at 426. Even though other actors such as Christopher Lee, Don Chaney and John Carradine had also played Count Dracula, the items in contention were modeled after the likeness of Bela Lugosi. See *id.* at 427. The court's analysis and ultimate decision turned on the issue of whether the right to exploit one's image is a personal right that can only be exercised during one's lifetime. See *id.* at 429-30. In holding that such right is personal, Justice Mosk propounded that an actor may only possess a proprietary interest in an "original creation" played by its "creator." See *id.* at 431; see also *Allen*, 610 F. Supp. at 612 (recognizing celebrity may be exploited by his character, thus supporting position that right of publicity protection should extend to characters identifying actors who create and portray them). Identification of whether an actor is exploited can be determined by whether an actor can create a unique fictional character or a unique character trait common to all characters played. See *id.*

57. In some situations, a casting director may call an actor to play a character based upon the allure of the actor's identity, while maintaining the integrity of a character unlike the actor's past roles. For a discussion of where right of publicity cases have also arisen in these types of casting situations, see *supra* note 53 and accompanying text.

58. This category is similar to where a character is based upon an actor with the addition of developing the character not in relation to the actor's persona, but rather based upon fictional elements. Examples of this type of casting and character development include the sitcom *Seinfeld* and *The Cosby Show*, in which the characters reflect the real lives of the actors, but with fictional elements. In *White v. Samsung Electronics America, Inc.*, 971 F.2d 1395 (9th Cir. 1992), for example, the defendant Samsung developed advertisements depicting a robot dressed in a wig, gown and jewelry that resembled Vanna White's hair and dress while positioned in front of a Wheel-of-Fortune like game board. See *id.* at 1396. The advertisement was captioned: "Longest-running game show. 2012 A.D." *Id.* The Ninth Circuit held in favor of Vanna White in deeming that her right of publicity had been violated. See *id.* at 1397-99. Although the robot itself did not resemble White, the wig, dress and position in front of the game board engendered a resemblance to White's identity. See *id.*; see also PROSSER, *supra* note 41, at 401-07. Professor Prosser explained right of publicity as such: "[I]t is not impossible that there might

acter with the same first name, but with fictional elements;<sup>59</sup> and (6) the actor plays a character who is dissimilar to himself or herself, but has become associated with the character.<sup>60</sup>

#### B. The Evolution of the Right of Publicity: Justifications Arising from Privacy Law

The right of publicity permits a celebrity to obtain relief against a defendant who unauthorizedly uses a celebrity's name, likeness or identity for commercial purposes.<sup>61</sup> A property-based concept at heart, the right of publicity finds its origins in privacy

be appropriation of the plaintiff's identity, as by impersonation, without the use of either his [or her] name or his [or her] likeness, and that this would be an invasion of his [or her] right of privacy." *Id.* at 389.

59. The difference between this category and the previous one is a change of the character's last name. For instance, Tony Danza frequently brings his own name to the characters that he plays in shows such as *Taxi*, *Who's the Boss*, and *The Tony Danza Show*. See *Eonline*, *Tony Danza*, at <http://www.eonline.com/Facts/People/Bio/0,128,4002,00.html> (last visited Nov. 24, 2001). The Third Circuit addressed the specific issue of whether right of publicity protection extends to an actor's character of the same first name in *McFarland v. Miller*, 14 F.3d 912, 914 (3d Cir. 1994). In that case, George McFarland played the character "Spanky" in the *Our Gang* series and came to be known as "Spanky McFarland" in recognition of this character. See *id.* at 915. The *Our Gang* series is described as: "The series' foundation was pitting scruffy, mischievous have-not kids against pretentious rich kids, sissy kids, and in general a hardened, rule-governed, class-conscious adult world that would stand between them and the only thing they were interested in—making their own fun." *Id.* at n.3 (citing Leonard Maltin & Richard Bann, *THE LITTLE RASCALS: THE LIFE AND TIMES OF OUR GANG 4* (1992)). McFarland brought suit for infringement on his right of publicity against a restaurant operating under the name "Spanky McFarland's" that used pictures of, and referenced the Little Rascals and *Our Gang* characters in its décor and menu. See *id.* at 916. The Third Circuit held that "where an actor's screen persona becomes so associated with him that it becomes inseparable from the actor's own public image," an actor may have a cause of action for infringement of his or her right of publicity by appropriating a character. *Id.* at 920. Citing the decision in *Lugosi*, the court reasoned that "the actor who develop[s] the image [has] the right to exploit it as superior to third parties which [have] nothing to do with the actor or the character identified with the actor." *Id.* at 921. The cynosure of the court's analysis relies on the fact that both the character and the actor possessed the same name, rather than on who first acquired the name "Spanky." See *id.* at 922.

60. This category identifies the situation where a character who has become "so associated with [the actor] that [the character] becomes inseparable from the actor's own public image, [thereby giving] the actor . . . an interest in the image which gives him [or her] standing to prevent mere interlopers from using it without authority." *McFarland*, 14 F.3d at 920. A notable point is that the actor may be able to develop a proprietary interest in his or her character when the actor brings an essence of originality to the role. See *id.* at 920. This requirement, however, may be criticized on the grounds that the "invention" requirement loses sight of the goal underlying the right of publicity, which is to protect actors from the commercial exploitation of their identities. See *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1353 (D.N.J. 1981).

61. See RESTATEMENT (THIRD) OF UNFAIR COMPETITION § 46 (1995); see also *Madow*, *supra* note 5, at 127-29. Typical examples of persons entitled to right of

law, which was developed in the late nineteenth century and incipiently discussed in a 1890 article by Samuel Warren and Louis Brandeis.<sup>62</sup> Warren and Brandeis argued that the law should recognize a "right to be let alone."<sup>63</sup> The article focused on the need to protect those suffering harm due to public disclosure of private facts.<sup>64</sup> Under a tort theory, protection was needed from disclosure in newspapers, editorials, books and photographs for which no legitimate public interest was deemed to be served.<sup>65</sup> It is precisely this notion that spurred the recognition of a cause of action when one's name or likeness was used for commercial purposes without consent. Though courts generally upheld the essence of the Warren-Brandeis privacy notion, some courts began to view the privacy rationale as being ill-suited to situations in which celebrities brought a cause of action over unauthorized uses of their likeness in the commercial context.<sup>66</sup> Due to privacy law's focus on "the right to

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publicity protection include famous actors, entertainers and professional athletes. See Madow, *supra* note 5, at 128-33.

62. See Lee Goldman, *Elvis is Alive, But He Shouldn't Be: The Right of Publicity Revisited*, 1992 BYU L. REV. 597, 599 (1992).

63. Samuel D. Warren & Louis D. Brandeis, *The Right to Privacy*, 4 HARV. L. REV. 193, 193 (1890) (discussing right to privacy doctrine).

64. See *id.* at 196, 215-16. The privacy right focused on an individual's injured feelings whose private details were exposed for public consumption, and thus was categorized as more of a mental anguish than a property-based tort. See, e.g., *Cardtoons, L.C. v. Major League Baseball Players Ass'n*, 95 F.3d 959, 967 (10th Cir. 1996) (noting right of publicity not only finds roots in privacy doctrine but also in business right to control use of identity in commerce rather than personal right or to maintain privacy); *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 728 (S.D.N.Y. 1978) (recognizing characterization of right of privacy as limiting right of person 'to be left alone' and protecting commercial exploitation of sentiments, thoughts and feelings of individual); *Cabaniss v. Hipsley*, 151 S.E.2d 496, 504 (Ga. Ct. App. 1966) (distinguishing between privacy right and property rights for commercial exploitation); see also 4 J. THOMAS MCCARTHY, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:01[3], 28-7 to -8 (4th ed. 1999) (analyzing disparity between privacy and publicity rights). McCarthy states:

The appropriation type of invasion of privacy, like all privacy rights, centers on damage to human dignity. Damages are usually measured by 'mental distress'—some bruising of the human psyche. On the other hand, the right of publicity relates to commercial damage to the business value of human identity. Put simplistically, while infringement of the right to publicity looks to an injury to the pocketbook, an invasion of appropriation privacy looks to an injury to the psyche.

*Id.*

65. See James H. Barron, *Warren & Brandeis, The Right to Privacy*, 4 HARV. L. REV. 193 (1890) *Demystifying a Landmark Citation*, 13 SUFFOLK U. L. REV. 875, 916 (1979). See generally J. THOMAS MCCARTHY, THE RIGHTS OF PUBLICITY AND PRIVACY (West Group, 2001).

66. See *Nimmer*, *supra* note 29, at 204-06; see also *O'Brien v. Pabst Sales Co.*, 124 F.2d 167, 170 (5th Cir. 1941) (rejecting privacy claim because plaintiff's pecuniary interests outweighed desire to protect privacy).

be left alone," celebrity plaintiffs did not find protection in instances where the court found that plaintiff's pecuniary interests outweighed good faith concerns over maintaining their private integrity.<sup>67</sup> Privacy law, therefore, focuses on the personal dignity of an individual.<sup>68</sup>

In response to the growing inadequacy of privacy law as applied to the quickly increasing commercial and economic value of celebrity status<sup>69</sup> arose the right of publicity doctrine as suggested by Melville Nimmer.<sup>70</sup> Nimmer, a renowned legal commentator, suggested that the right of publicity is the "right of each person to control and profit from the publicity values which he has created or purchased."<sup>71</sup> Nimmer intimated that celebrities' recognizable names and likeness carried considerable economic value when used for the commercial enterprise of the promotion and sale of goods and services resulting from the celebrity's expenditure of time, money and effort to achieve public status.<sup>72</sup> Following this line of reasoning, granting a right of publicity to these celebrities comports with the labor principle that something of value is entitled to the fruits of its economic gain.<sup>73</sup> Thus, the celebrity creates a property to which there is attached a bundle of rights.<sup>74</sup> Essentially,

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67. See *O'Brien*, 124 F.2d at 168-70 (determining *O'Brien* was not entitled to right of privacy protection); see also Patricia B. Frank, *White v. Samsung Electronics America, Inc.: The Right of Publicity Spins Its Wheels*, 55 OHIO ST. L.J. 1115, 1115 (1994) ("Since the 1950s, American law has recognized a property right in a person's publicity as 'the right of each person to control and profit from the publicity values which he has created.'") (quoting Nimmer, *supra* note 29, at 216); Steven C. Clay, Note, *Starstruck: The Overextension of Celebrity Publicity Rights in State and Federal Courts*, 79 MINN. L. REV. 485, 488 (1994) ("Some courts were reluctant to apply privacy rights to celebrities, stating that celebrities waived any right 'to be let alone' through their active pursuit of and profit from fame.").

68. See Robinson, *supra* note 43, at 184-85 (defining right to privacy framework as personal in nature).

69. See Nimmer, *supra* note 29, at 203 (discussing inadequacies of privacy law doctrine); Robinson, *supra* note 43, at 184 ("The right of publicity was conceived as a solution to the problems caused when celebrities attempted to use the right of privacy, and/or the tort of appropriation, to protect pecuniary interests.").

70. See Nimmer, *supra* note 29, at 203-04.

71. *Id.* at 216.

72. See *id.* at 215-16.

73. See *id.* at 216.

74. See JOHN LOCKE, TWO TREATISES OF GOVERNMENT, bk. II, §§ 25-51, at 285-302 (Peter Laslett ed., 2d ed. 1967). Locke's theory of natural law proposes the notion that the expenditure of labor lays a foundation for property rights. See *id.*; see also Wendy J. Gordon, *A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property*, 102 YALE L.J. 1533, 1540 (1993) (discussing relationship between Locke's theory and law of intellectual property).

Nimmer proposed the idea that the foundation for a right of publicity claim does not truly exist within the right of privacy.<sup>75</sup>

In his seminal article on right of publicity,<sup>76</sup> William Prosser divided the right of privacy into four separate torts: (1) "Intrusion upon the plaintiff's seclusion or solitude, or into his private affairs; (2) Public disclosure of embarrassing private facts about the plaintiff; (3) Publicity which places the plaintiff in a false light in the public eye; and (4) Appropriation for the defendant's advantage of the plaintiff's name or likeness."<sup>77</sup> In his discussion, Prosser focused largely on name and likeness appropriations,<sup>78</sup> though noting that extension beyond this realm was entirely possible: "[I]t is not impossible that there might be appropriation of the plaintiff's identity, as by impersonation, without the use of either his name or his likeness, and that this would be an invasion of his right of privacy."<sup>79</sup> Thus, not only can the evolution of the publicity doctrine be traced to the privacy doctrine, but it also finds strong roots within it.<sup>80</sup>

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75. See Nimmer, *supra* note 29, at 203-04. Nimmer stated:

Well known personalities connected with these industries [including the advertising, motion picture, television and radio] do not seek the "solitude and privacy" which Brandeis and Warren sought to protect. Indeed, privacy is the one thing they do "not want, or need." Their concern is rather with publicity, which may be regarded as the reverse side of the coin of privacy. However, although the well known personality does not wish to hide his light under a bushel of privacy, neither does he wish to have his name, photograph, and likeness reproduced and publicized without his consent or without remuneration to him.

*Id.* (citations omitted).

76. See Robinson, *supra* note 43, at 185 (acknowledging adoption of Prosser's right of privacy framework into RESTATEMENT (SECOND) OF TORTS as having "spurred discussion of the creation of a separate right of publicity"); Clay, *supra* note 67, at 490 (identifying Prosser as universally cited in right of publicity cases).

77. Prosser, *supra* note 44, at 389.

78. See *id.* at 401. Many courts look to Prosser's discussion of right of publicity as one of the earliest and most enduring articulations of the common law right. See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1397 (9th Cir. 1992); see Burnett, *supra* note 6, at 175-76 (discussing Prosser's theories on privacy doctrine as root of publicity doctrine).

79. Prosser, *supra* note 44, at 401 n.155. Prosser further states that the misappropriation tort was distinguishable from the others on the grounds that it was more of a proprietary tort than one of mental anguish. See *id.* at 406-07.

80. See Hetherington, *supra* note 4, at 4 ("The seeds of celebrity rights lay in the novel doctrine of privacy.").

### III. AN OVERLAP OF A HOST OF ISSUES: A COMPARATIVE APPROACH ON THE RIGHT OF PUBLICITY, FEDERAL COPYRIGHT LAW AND FIRST AMENDMENT CONCERNS

#### A. The Federal Copyright Act: The Fair Use Model

Though the right of publicity is currently recognized as a legal doctrine independent from notions spurred by privacy law, legislatures and courts face a precarious balance between private and public sectors as to the scope of the protections allowed. In the face of celebrity rights exploitation, the exigency of a workable model becomes increasingly evident.<sup>81</sup> The right of publicity is evolving toward the protection of a celebrity's identity beyond the traditional scope of name, photograph and likeness.<sup>82</sup>

In striking an adequate balance between public and private interests, courts theoretically favor the fair use doctrine as codified by the 1976 Copyright Act.<sup>83</sup> In order to "promote the Progress of Science and useful Arts,"<sup>84</sup> copyright law in the United States grants exclusive control rights to creators of "original works of authorship"<sup>85</sup> that include literary, musical, artistic, dramatic and certain other works. Courts have generally adhered to the view that granting financial rewards are the optimal means to encourage reproduction of creative works, while alluring the original author to maintain exclusive entitlement to their work.<sup>86</sup> Copyright, therefore, provides the necessary incentives and protections to promote the production of new works.<sup>87</sup>

The origins of American copyright law derive from the English scheme of copyright protection, originally enacted in 1710 as the

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81. For a further discussion of the exigency of a workable right of publicity statute, see *infra* notes 147-66 and accompanying text.

82. For a discussion of the scope of protection of right of publicity, see *supra* notes 45-60 and accompanying text.

83. See 17 U.S.C.A. § 107 (2001).

84. U.S. CONST. art. I, § 8, cl. 8.

85. 17 U.S.C. § 102(a) (West, 2001).

86. See *Leibovitz v. Paramount Pictures, Inc.*, 948 F. Supp. 1214, 1218 (S.D.N.Y. 1996).

87. See Benjamin Ely Marks, *Copyright Protection, Privacy Rights, and the Fair Use Doctrine: The Post-Salinger Decade Reconsidered*, 72 N.Y.U. L. Rev. 1376, 1376-77 (1997). Marks examines *Salinger v. Random House, Inc.*, 811 F.2d 90 (2d Cir. 1987), a case in which the Second Circuit granted J.D. Salinger an injunction barring the publication of the author's biography. See *id.* at 1376. The Second Circuit's decision was a part of a controversial line of cases revolving about copyright infringement law and the fair use doctrine. See *id.* These cases engendered a plethora of criticism and activity by Congress among the legal community, publishers and academics who believed that the decision narrowed the fair use doctrine. See *id.*



Statute of Anne.<sup>88</sup> Since this time, Congress has passed a number of copyright statutes to meet the dual purposes of copyright law.<sup>89</sup> To stimulate creativity, copyright law provides economic incentives to creators by granting the author exclusive control over an original, expressive work.<sup>90</sup>

Adequate economic incentives are usually provided to an author to create original works and share them with the public because a copyright monopoly grants rights of exclusive control to reproduce, distribute and display a work.<sup>91</sup> However, because the copyright monopoly may stifle creativity in certain circumstances since it also extends to the author the right to prepare derivative works,<sup>92</sup> a second author may be discouraged from building upon

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88. See 1 MELVILLE B. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT § 1.08[B] (1991) (discussing English origins of American copyright scheme and scope of writings protected by copyright). According to Nimmer, “[a]t one extreme, the defendant’s use of a copyrighted work in an advertising context is probably least likely to justify a fair use defense, even if the plaintiff’s copyrighted work, as well as defendant’s use thereof, were both for advertising purposes.” *Id.* at § 13.05[A][1][c].

89. For a general historical perspective of copyright law, see Marks, *supra* note 87, at 1381-83; see also ROBERT A. GORMAN & JANE C. GINSBURG, COPYRIGHT 1-12 (5th ed. 1999).

90. See *Mazer v. Stein*, 347 U.S. 201, 219 (1954) (discussing the economic philosophy behind the clause empowering Congress to grant patents and copyrights). This philosophy encourages individual effort because “personal gain is the best way to advance public welfare through the talents of authors and inventors in ‘Science and useful Arts.’” *Id.* “Sacrificial days devoted to such creative activities deserve rewards commensurate with the services rendered.” *Id.* But see *Feist Publ’ns, Inc. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 344-51 (1991) (determining that ultimate goal of copyright law is to encourage production of new works and not necessarily to compensate author of such works).

91. See Wendy J. Gordon, *Fair Use as Market Failure: A Structural and Economic Analysis of the Betamax Case and Its Predecessors*, 82 COLUM. L. REV. 1600, 1602 (1982) (determining that dual aims of copyright—financial incentive to authors and promotion of science and useful arts—rarely conflict because authors are given adequate compensation for their efforts); see also 17 U.S.C. § 106 (2001). Section 106 states that an author has the exclusive rights:

(1) to reproduce the copyrighted work in copies or phonorecords; (2) to prepare derivative works based upon the copyrighted work; (3) to distribute copies or phonorecords of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending; (4) in the case of literary, musical, dramatic, and choreographic works, pantomimes, and motion pictures and other audiovisual works, to perform the copyrighted work publicly; (5) in the case of literary, musical, dramatic and choreographic works, pantomimes, and pictorial, graphic, or sculptural works, including the individual images of a motion picture or other audiovisual work, to display the copyrighted work publicly; and (6) in the case of sound recordings, to perform the copyrighted work publicly by means of a digital audio transmission.

*Id.*

92. See 17 U.S.C. § 103(a) (1994) (“The subject matter of copyright . . . includes compilations and derivative works . . .”). A derivative work transforms or

the work of the original author during the existence of the original copyright.

With the dual aims of copyright law<sup>93</sup> at the forefront of its considerations, the fair use doctrine is quite possibly the most significant limitation of copyright protection<sup>94</sup> and remains an affirmative defense to copyright infringement.<sup>95</sup> As a judge-made rule of reason,<sup>96</sup> Congress deliberately created a vague statute when it enacted section 107.<sup>97</sup> This statute enumerates four factors that include an examination of the purpose and character of use, the nature of the copyrighted work, the amount and substantiality of the portion used in relation to the copyrighted work as a whole and the effect of the use on the potential market for or value of the copyrighted work.<sup>98</sup> These factors are weighed in the aggregate.<sup>99</sup> Although Congress did not assign relative weights to these statutory

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adapts one or more preexisting works such that the product incorporates an original work of authorship. See Ronald Urbach, *Protection and Use of Copyrightable Material in the New Media Age*, 775 PLI/Comm. 449, 463 (1997).

93. The dual aims of copyright law are to stimulate creativity and to disseminate knowledge in order to enrich culture and foster the growth of learning for the public welfare. See *Twentieth Century Music Corp. v. Aiken*, 422 U.S. 151, 156 (1975) (delineating between immediate effect of copyright law to secure fair return for author's creative work and ultimate aim to stimulate artistic creativity).

94. See Marks, *supra* note 87, at 1377 and accompanying text. After stating that the fair use doctrine is perhaps the most significant limitation on copyright protection, Marks contemplates that because the doctrine arose out of judicial recognition that "certain acts of copying are defensible when the public interest in permitting the copying far outweighs the author's interest in copyright protection," it permits "copying of otherwise protected expression 'to such a quantitative or qualitative degree that absent a valid fair use claim, judgment for plaintiff is mandated.'" *Id.* (citing WILLIAM F. PATRY, *THE FAIR USE PRIVILEGE IN COPYRIGHT LAW*, 413 (2d ed. 1995)).

95. See *id.* See generally Jeannette R. Busek, *Copyright Infringement: A Proposal for a New Standard for Substantial Similarity Based on the Degree of Possible Expressive Variation*, 45 UCLA L. REV. 1777, 1782-85 (1998) (explaining Copyright Act and copyright infringement).

96. See Marks, *supra* note 87, at 1377 and accompanying text.

97. See *id.* at 1377-78. Marks contemplates that Congress intentionally neither sought to change prior law nor inhibit future judicial development for the purpose of remaining loyal to the original common law character of the doctrine. See *id.* The doctrine finds origin in *Folsom v. Marsh*, where Justice Story articulated a set of formulations on how to approach the concept of fair use which was later codified in section 107 of the Copyright Act. See *Folsom*, 9 F. Cas. 342, 348 (C.C.D. Mass. 1841).

98. See 17 U.S.C.A. § 107 (2001).

99. See *Leibovitz v. Paramount Pictures, Inc.*, 137 F.3d 109 at 112-13 (2d Cir. 1998). The court emphasized that the aggregate weighing signifies a modification of the court's previous view that the fourth factor was the most prominent element in the balance of the four factors. See *id.* at 113. But see Martin Flumenbaum & Brad S. Karp, *Court Twice Rejects "Fair Use" Defense*, N.Y. L.J., Aug. 26, 1998, at 3 (stating that Copyright Act supports individual-episode analysis, not aggregate analysis).

factors, courts are given discretion to value each factor disproportionately.<sup>100</sup>

The affirmative defense of fair use was inculcated under copyright law to address the excessive protection received by an original author to prepare derivative works.<sup>101</sup> The fair use defense “permits other people to use copyrighted material without the owner’s consent in a reasonable manner for certain purposes.”<sup>102</sup> Unreasonable use of the original work can be shown by direct evidence that the defendant copied the material or that the defendant not only had “access to the plaintiff’s copyrighted work,” but also that the “defendant’s work is substantially similar to the plaintiff’s copyrightable material.”<sup>103</sup> Courts, however, will construe section 107 of the 1976 Copyright Act to permit a fair use defense for works of parody,<sup>104</sup> as such works “are valued forms of criticism, encouraged because this sort of criticism itself fosters the creativity proposed by the copyright law.”<sup>105</sup> Therefore, a defendant who takes a substantive amount of copyrighted material, without securing the permission of the owner, may defend the parody as a fair use of the original work.

In examining the fair use question, courts look to a set of formulations originally articulated by Justice Story in *Folsom v.*

100. See Marks, *supra* note 87, at 1378 and accompanying text. Furthermore, Marks explores the problems arising from the lack of judicial guidance that have made the area of alleged copyright infringement of unpublished materials “particularly prickly.” See *id.*

101. See *Leibovitz*, 137 F.3d at 112 (asserting that both sides disagree only to availability of affirmative defense of fair use since there is no dispute over plaintiff’s prima facie case of infringement).

102. *Rogers v. Koons*, 960 F.2d 301, 308 (2d Cir. 1992).

103. *Computer Assocs. Int’l, Inc. v. Altai, Inc.*, 982 F.2d 693, 701 (2d Cir. 1992).

104. See 17 U.S.C. § 107 (2001). Fair uses listed in the statute include the use of copyrighted works for “criticism, comment, news reporting, teaching . . . scholarship, or research.” *Id.* However, “types of uses beyond the six enumerated in the preamble to section 107 may be considered. Parody is a common example of such a use.” H.R. REP. NO. 102-836, at 3 n.6 (1992); see also *Dr. Seuss Enters. v. Penguin Books USA, Inc.*, 109 F.3d 1394, 1400 (9th Cir. 1997) (determining that “[p]arody is regarded as a form of social and literary criticism, having a socially significant value”).

105. *Rogers*, 960 F.2d at 310. Additionally, copyright law acts as a practical device that provides benefits for authors and artists. See Pierre N. Leval, *Toward a Fair Use Standard*, 103 HARV. L. REV. 1105, 1109 (1990). In recognizing the benefits copyright law confers on authors and artists, Leval noted that such benefit is conferred in order to promote the intellectual and practical enrichment that emanates from creative and innovative activity. See *id.* Leval concluded that copyright law is therefore necessary to attain this goal. See *id.*

*Marsh*.<sup>106</sup> These formulations were later codified in section 107 of the Copyright Act.<sup>107</sup> This set of formulations includes four factors to be evaluated in determining whether the use of the work is fair use.<sup>108</sup> Fair use analysis proceeds on a case-by-case

106. 9 F. Cas. 342 (C.C.D. Mass. 1841) (No. 4901). Justice Story identified a number of factors for consideration, including the "nature and objects of the selections made, the quantity and value of the materials used, and the degree in which the use may prejudice the sale, or diminish the profits, or supersede the objects, of the original work." *Id.* at 348.

107. See 17 U.S.C.A. § 107 (2001). Congress codified the common law concept of fair use in the Copyright Act: "The fair use of a copyrighted work . . . for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright." *Id.*

108. See *Castle Rock Entm't, Inc. v. Carol Publ'g Group, Inc.*, 150 F.3d 132, 141 (2d Cir. 1998) (quoting 17 U.S.C. § 107). The four factors include: (1) the purpose and character of the use, including whether such use is of a commercial nature or is of nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work. See 17 U.S.C. § 107 (2001).

The first of the fair use factors examines both the purpose and character of the use. See 17 U.S.C. § 107(1) (2001). In *Campbell v. Acuff-Rose*, 510 U.S. 569 (1994), the Supreme Court faced a commercial parody that was asserted to be a fair use and held that for the first factor, the critical inquiry entailed whether the second work "adds something new, with a further purpose or different character, altering the first with new expression, meaning, or message; it asks, in other words, whether and to what extent the new work is 'transformative.'" See *Campbell*, 510 U.S. at 570. The Court went on to state, "the more transformative the new work, the less will be the significance of other factors, like commercialism, that may weigh against a finding of fair use." *Id.* See also David Goldberg & Robert J. Bernstein, *Demi Moore, Dr. Seuss and Seinfeld: Fair Use*, N.Y. L.J., May 16, 1997, at 1 (stating that the existence of "transformative" purpose does not guarantee a successful claim of fair use). Additionally, the justification for a transformative purpose must supersede the remaining factors that favor the copyright holder. See Leval, *supra* note 105, at 1111. Although "transformative" use of the original work is imperative under this factor, it is not determinative for a finding of fair use because this factor must be weighed in the aggregate in relation to the remaining three factors. See Leval, *supra* note 105, at 1116 and accompanying text. Leval states that though a finding of justification under the first factor is imperative to the warranting of a fair use defense, this factor should be weighed against the remaining factors, keeping in mind the copyrights owner's incentives and ownership rights. See *id.*

The second statutory factor concerns the nature of the copyrighted work. See *Campbell*, 510 U.S. at 586. This factor represents the acknowledgement that certain works are closer to the heart of copyright than others; fair use is therefore more difficult to establish when a corework is copied than when an infringer takes material that falls only marginally within copyright protection. See *id.* at 586 ("[F]air use is more difficult to establish when the former works are copied. . . ."); see, e.g., *Stewart v. Abend*, 495 U.S. 207, 237-38 (1990) (contrasting a fictional short story with factual works); *Feist Publs. v. Rural Tel. Serv. Co.*, 499 U.S. 340, 348-51 (1991) (contrasting creative works with bare factual compilations). Analysis of the second statutory factor hinges upon whether the work is a collection of facts rather than a creative or imaginative work. See Alexandra Lyras, *Incidental Artwork in Television Scene Backgrounds: Fair Use of Copyright Infringement?*, 2 FORDHAM INTELL. PROP. MEDIA & ENT. L.J. 159, 182 (1992) (stating that when the copyrighted material is

collection of facts, fair use doctrine allows more liberal use of copyrighted work); see *Stewart*, 495 U.S. at 207. The Supreme Court in *Stewart* held that the scope of fair use is narrower for fictional works than for factual works. See *Stewart*, 495 U.S. at 207. In *Stewart*, the holder of rights in a magazine story brought an infringement action against the holders of rights in a motion picture that had been created from the story. See *id.* Though the district court granted relief in favor of the holders of rights in a motion picture who created the derivative work under the fair use analysis, the Ninth Circuit later reversed this decision and the Supreme Court affirmed based upon the same four factor fair use analysis. See *id.* at 207. The rationale of this consideration lies in the idea that certain works are closer to the "heart" of the original than others and that a finding of fair use is less likely for a work that is copied than one which comments upon or conjures up the copyrighted work. See *Feist*, 499 U.S. at 348-51 (contrasting factual works with fictional works considered to be creative).

Turning to the third factor regarding the amount and substantiality of the portion use in relation to the copyrighted work as a whole, the *Campbell* Court adopted the rule developed in prior case law that because the humor of parody necessitates a readily recognizable reference to the underlying original work, a parodist is entitled to make use of as much of the first work as is required to "conjure up" the original. See *Campbell*, 510 U.S. at 588 ("[T]he parody must be able to 'conjure up' at least enough of that original to make the object of its critical wit recognizable."). Further, the Court held that the parodist can use more of the original than the minimum amount necessary to assure identification provided that the parody is either targeted at the underlying work or will not serve as a market substitute for the original. See *id.* (stating once enough has been taken to assure identification, how much more is reasonable will depend on, for example, extent to which song's overriding purpose and character is to parody original or, in contrast, likelihood that parody may serve as market substitute for original). Finally, Souter of the *Campbell* Court recognized that parodic copying of the "heart" of the original work is not an excessive use because the parody would likely be recognizable without the use of the more memorable part of the original. See *id.* (stating that if parodist had copied significantly less memorable part of original, it is difficult to see how its parodic character would have come through).

The final factor considers the "effect of the use upon the potential market for or value of the copyrighted work." 17 U.S.C. § 107(4) (2001). Because fair use is an affirmative defense, the Court reasoned that the burden of proving lack of market impairment shifts to the defendant. See *Campbell*, 510 U.S. at 590. Although no single element of the fair use test is dispositive, in light of the underlying purposes of copyright, the Supreme Court has recognized that its final factor is "undoubtedly the single most important element of fair use." See *Harper & Row, Publishers, Inc. v. Nation Enters.*, 471 U.S. 539, 566 (1985). The centrality of this factor results not from courts according disproportionate weight to it, but from its close link to the other fair use factors, including the purpose and character of the use and the extent of the portion taken. See *Leibovitz v. Paramount Pictures Corp.*, 948 F. Supp. 1214, 1225 (S.D.N.Y. 1996) (stating parody as genre occupies different position than other assertedly fair uses, because parodist is entitled to damage market for original, but only in certain ways). The underlying idea behind this factor is the acknowledgement that copyright is not an inherent right in authorship. See *Leval*, *supra* note 105, at 1124. An important inquiry is whether "[t]he use tends to interfere with the sale of the copyrighted article." *Id.* The idea behind copyright is to allow authors the chance to garner rewards by encouraging them to create works. See *id.* A secondary user's gross interference with an author's pursuits would undermine this goal of copyright. See *id.* See *Mura v. Columbia Broad. Sys.*, 245 F. Supp. 587, 587 (S.D.N.Y. 1965). See generally *Adrienne J. Marsh, Fair Use and New Technology: The Appropriate Standards to Apply*, 5 CARDOZO L. REV. 635, 643 (1984).

basis.<sup>109</sup> Furthermore, the analysis will always be considered in light of the primary objective of copyright law - to "promote the Progress of Science and useful Arts."<sup>110</sup>

Although fair use is an extremely flexible common law doctrine that developed over time, this approach, nevertheless, has its drawbacks. In the burgeoning business environment of entertainment, advertisements, celebrities and their attorneys, an ad hoc application of the four relative factors of the fair use doctrine remains impractical and not tailored enough to meet the time-sensitive needs of the celebrity-oriented business. Furthermore, the complex nature of the copyright process dictates a need for a more elastic approach in defining the relationship between the public figure and the public.

Additionally, application of the fair use doctrine ignores the specific industry of celebrity-based business. The fair use doctrine's application has been limited mostly to literary property and thus, although the first two prongs of the test are relevant to a right of publicity analysis, the remaining factors are applied as a formality and require unwarranted legal reasoning that unnecessarily wastes judicial resources.

An illustration of the application of the fair use model demonstrates the failure of the doctrine to meet right of publicity concerns. Purpose and character of usage are relevant concerns in the determination of whether a celebrity may or may not be afforded legal protection. However, the third factor of "effect of the use upon the potential market for or value of [one's identity]"<sup>111</sup> is outweighed by the First Amendment concerns discussed in the next section.<sup>112</sup> The fourth prong of "amount and substantiality" of use, though relevant in the context of literary property where multiple pages of a text are lifted as part of another text, remains largely inapplicable and irrelevant to publicity claims. When a celebrity's identity has been exploited, a wrongful commercial gain has been obtained, whether the use was minimal or not.<sup>113</sup> This gain must have been the purpose of evoking the celebrity's image; as such, the

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109. See *Castle Rock*, 150 F.3d at 141 (quoting *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569, 577 (1994)).

110. *Id.*

111. *Roy Export Co. Establishment of Vaduz v. CBS*, 503 F. Supp. 1137, 1137-1143 (S.D.N.Y. 1980).

112. For a further discussion of First Amendment concerns, see *infra* notes 115-31 and accompanying text.

113. See *Allen v. Nat'l Video*, 610 F. Supp. 612, 622 (S.D.N.Y. 1985); *Onassis v. Christian Dior-New York, Inc.*, 472 N.Y.S.2d 254, 260 (N.Y. Sup. Ct. 1984), *aff'd*, 488 N.Y.S.2d 943 (N.Y. App. Div. 1985).

amount and substantiality of use becomes irreconcilable with the wrongful commercial benefit already obtained.<sup>114</sup>

## B. First Amendment Concerns

Despite the fact that the First Amendment has not been the focus of right of publicity analyses in courts,<sup>115</sup> it is, nevertheless, directly implicated because the right of publicity involves a communicative tort.<sup>116</sup> The First Amendment was designed by the Framers of the Constitution to protect the freedoms of speech and press.<sup>117</sup> In *Whitney v. California*,<sup>118</sup> Justice Brandeis in 1927 outlined the underlying goals of the First Amendment for safeguarding free

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114. See *Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1288 (9th Cir. 1999) (Kozinski, J., dissenting). Additionally, in his dissent to an en banc hearing, Judge Kozinski presages that just as state law regulating the length of trucks is invalid under the Dormant Commerce Clause if it poses an undue burden on interstate commerce, so too is a state's right of publicity law invalid if it substantially interferes with federal copyright law, even absent preemptive legislation.

115. See Frank, *supra* note 67, at 1136 (discussing lack of First Amendment attention by courts in right of publicity analyses); Halpern, *supra* note 4, at 868 (discussing same). Frank propounds that courts do not consider First Amendment concerns in right of publicity analyses because courts view an individual as merely seeking compensation for use of his or her identity. See Frank, *supra* note 67, at 1136. Accordingly, the plaintiff does not seek to withhold appropriation of identity altogether. See *id.*

116. See Halpern, *supra* note 4, at 867 ("By its nature, the right of publicity implicates speech: whatever else it may be, the right of publicity involves a communicative tort. Of course, such a characterization merely starts — and does not resolve — a First Amendment inquiry."); Hetherington, *supra* note 4, at 21 ("The most forceful argument against a wholesale extension of the right of publicity can be found in the First Amendment's policy of promoting the free flow of ideas essential to vigorous public discourse."); see also Peter L. Felcher & Edward L. Rubin, *Privacy, Publicity, and the Portrayal of Real People by the Media*, 88 YALE L.J. 1577, 1577 n.2 (1979). Hetherington argues that the First Amendment is not an absolute limitation on the right of publicity. See Hetherington, *supra* note 4, at 21. James Barr Haines, in *First Amendment II: Developments in the Right of Publicity*, 1989 ANN. SURV. AM. L. 211, 225-26 (1989) also delineates the conflict between right of publicity and First Amendment. Specifically, Haines states:

By protecting the freedoms of speech and the press, the [F]irst [A]mendment promotes democratic self-government, facilitates the search for truth, and protects the free flow of information through such media as magazines, newspapers, television, and film. At the same time, the right of publicity creates an exclusive right in an individual to the commercial use of his or her identity. The [F]irst [A]mendment and the right of publicity conflict when a person commercially benefits from a constitutionally protected use of another's identity.

*Id.*

117. See U.S. CONST. amend. I. The First Amendment states: "Congress shall make no law respecting an establishment of religion, or prohibiting the free exercise thereof; or abridging the freedom of speech, or of the press; or the right of the people peaceably to assemble, and to petition the Government for a redress of grievances." *Id.*

118. 274 U.S. 357 (1927).

speech: the enlightenment function; the self-fulfillment function; and the safety valve function.<sup>119</sup> Most courts that have considered First Amendment concerns in right of publicity issues delineate between uses of identity that are purely commercial as opposed to uses of free speech that are protected.<sup>120</sup> A balance of interests, therefore, presents a difficult task that introduces challenging policy questions for the courts.<sup>121</sup>

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119. See *id.* at 375 (Brandeis, J., concurring). See generally Melville B. Nimmer, NIMMER ON FREEDOM OF SPEECH, §§ 1.02-04 (1984); Hetherington, *supra* note 4, at 190-91. With regard to the enlightenment function, Hetherington states that it encompasses news as well as entertainment, and that the bulk of constitutional doctrine has developed under the armor of the enlightenment function. See Hetherington, *supra* note 4, at 190. The second reason for safeguarding free speech under the Brandeis formula is the self-fulfillment function. Brandeis suggests that freedom of speech is an end in itself because it serves to validate the humanity of the speaker, thus serving not only the political needs of democracy but also of the human spirit. See *id.* at 190-91. Hetherington also notes that such self-expression encourages the development of political and social ideas intrinsic to a healthy society. See *id.* The safety valve function has not played a significant role in right of publicity analyses, primarily because of its political entanglement. See *id.* at 191. In particular, Hetherington states:

The safety valve function has not played a part in the development of the right of publicity, probably because the factors at work are more exclusively political. Brandeis formulated this branch as a means of preventing violence in the pursuit of political goals, suggesting that speech advocating these goals would release the emotions in a non-violent setting. The right of publicity must be crafted so as to facilitate these important constitutional values, while providing the breathing space necessary for free speech rights to flourish. The restrictions on the use of one's personality must be clearly delineated to accommodate the enlightenment and self-fulfillment functions. As one court urged in an early right of publicity case, "[o]ne must never lose sight of the purpose behind the decisions implementing the First Amendment."

*Id.*

120. See, e.g., *Midler v. Ford Motor Co.*, 849 F.2d 460, 462 (9th Cir. 1988) (discussing media's use of identity as cynosure of examination); see also *Felcher & Rubin*, *supra* note 116, at 1596 ("If [the purpose of the portrayal] serves an informative or cultural function, it will be immune from liability; if it serves no such function but merely exploits the individual portrayed, immunity will not be granted.").

121. See *Robinson*, *supra* note 43, at 198 ("Weighing First Amendment principles against the right of publicity is a difficult task."); see also *Frank*, *supra* note 67, at 1136 ("The other major block towards recognizing a First Amendment defense in these [right of publicity] cases has been the slight protection granted commercial speech."). Frank notes that the level of First Amendment protection is significantly lowered when a commercial interest is involved, thus making it more difficult for a defendant to prove his right to freedom of expression has been violated. See *Frank*, *supra* note 67, at 1136. See generally *Halpern*, *supra* note 4, at 868 (discussing First Amendment concerns in right of publicity). Halpern states that:

[At] the outer edges of the right of publicity, there may be challenging questions of policy. For example, imitation and impersonation create difficult issues; interests must be balanced in order to protect the personality interest from appropriation while preserving the equally deserving areas of parody, satire, and self-conscious impersonation.

*Id.*



The Supreme Court directly balanced First Amendment concerns against right of publicity in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>122</sup> Coined the “human cannonball” case, the Court agreed with Zacchini by a five-four margin that the filming of his human cannonball performance at a county fair in Ohio by a television reporter with a movie camera constituted an “unlawful appropriation [of his] professional property.”<sup>123</sup> In balancing Zacchini’s allegation against the defendant newspaper’s argument that the First and Fourteenth Amendments protected its right to broadcast Zacchini’s entire performance without compensation,<sup>124</sup> the Court historically recognized the right of publicity as an established cause of action with significant rational and economic underpinnings.<sup>125</sup> The facts in *Zacchini* were unusual, and the Court’s narrowly tailored decision did not “deliberately or otherwise . . . establish a general test balancing the right of publicity against First Amendment freedoms.”<sup>126</sup> The *Zacchini* decision therefore, left the possibility of preemption of state publicity right laws, based upon federal copyright or First Amendment grounds, an open playing field.

Decisions following *Zacchini* generally hold that First Amendment concerns preempt right of publicity interests.<sup>127</sup> Invariably, courts subordinate interests protected by the right of publicity under competing free speech interests when faced with a conflict between the two.<sup>128</sup> For example, the Tenth Circuit held that the First Amendment preempted the right of publicity in an Oklahoma case that arguably involved commercial speech.<sup>129</sup> Similarly, a New York district court held likewise.<sup>130</sup> Furthermore, in Pennsylvania, a

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122. 433 U.S. 562 (1977).

123. *Id.* at 564.

124. *See id.* at 565 (noting issue of First and Fourteenth Amendment immunity from damages for alleged infringement of right of publicity unresolved).

125. *See Robinson, supra* note 43, at 187-88 (discussing *Zacchini* and potential application of balancing right of publicity against First Amendment).

126. *Id.* at 197-98.

127. *See, e.g.,* *Cardtoons, L.C. v. Major League Baseball Players Ass’n*, 95 F.3d 959, 976 (10th Cir. 1996); *Rogers v. Grimaldi*, 875 F.2d 994, 1004-05 (2d Cir. 1989) (holding right of publicity preempted when balanced against First Amendment interests); *Hicks v. Casablanca Records*, 464 F. Supp. 426, 433 (S.D.N.Y. 1978) (finding First Amendment took precedence over plaintiff’s publicity rights).

128. *See Haines, supra* note 116, at 226 (“[C]ourts almost invariably subordinate the interests protected by the right of publicity to competing free speech interests.”).

129. *See Cardtoons*, 95 F.3d at 968, 976 (holding First Amendment preempted Oklahoma’s right of publicity statute which closely parallels sections 990 and 3344 of California Civil Code).

130. *See N.Y. Magazine v. Metro. Transit Auth.*, 987 F. Supp. 254, 266-68 (S.D.N.Y. 1997) (invoking First Amendment and judicial exceptions to New York’s

district court held that the First Amendment preempted the state's common law right of publicity.<sup>131</sup>

#### IV. ALL EYES ARE WATCHING *WENDT v. HOST INTERNATIONAL, INC.*

In *Wendt v. Host International, Inc.*,<sup>132</sup> the Ninth Circuit asserted a broad interpretation of the right of publicity.<sup>133</sup> The court expanded the purview of publicity protection to include mechanical reproduction.<sup>134</sup> Actors George Wendt and John Ratzenberger of the popular television show "Cheers" sued Host International, Inc. ("Host") and Paramount Pictures Corporation ("Paramount") claiming that both companies violated their publicity rights.<sup>135</sup> Host obtained a license from Paramount to create a chain of bars at airports based on the television show "Cheers."<sup>136</sup> In each of these restaurants or bars, Host placed "three dimensional" animatronic figures that bore the likeness of plaintiffs' characters on "Cheers."<sup>137</sup> Plaintiffs Wendt and Ratzenberger, who respectively

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right of publicity statute to deny New York Mayor Rudolph W. Giuliani's attempt to enjoin commercial exploitation of his name).

131. See *Seale v. Gramercy Pictures*, 949 F. Supp. 331, 337 (E.D. Pa. 1996) (marking unsuccessful invocation of common law right of publicity against makers of docudrama Panther by former Black Panther leader Bobby Seale).

132. 125 F.3d 806 (9th Cir. 1997), *cert. denied*, *Paramount Pictures v. Wendt*, 531 U.S. 811 (2000).

133. See *id.*

134. See *id.* at 810 (holding issues of material fact exist concerning degree to which animatronic reproductions of plaintiffs' characters on TV show resembled, caricatured, or bear impressionistic resemblance to appellants).

135. See *Wendt*, 125 F.3d at 809. In his dissenting opinion whereby a petition for rehearing was denied and a petition for rehearing en banc was rejected for the case at bar, Judge Kozinski of the Ninth Circuit fondly remembered the popular television series, "Cheers":

Though a bit dated now, "Cheers" remains near and dear to the hearts of many TV viewers. Set in a friendly neighborhood bar in Boston, the show revolved around a familiar scene. Sam, the owner and bartender, entertained the boys with tales of his glory days pitching for the Red Sox. Coach piped in with sincere, obtuse advice. Diane and Frasier chattered self-importantly about Lord Byron. Carla terrorized patrons with acerbic comments. And there were Norm and Cliff, the two characters at issue here. Norm, a fat, endearing, oft-employed accountant, parked himself at the corner of the bar, where he was joined by Cliff, a dweebish mailman and something of a know-it-all windbag. After eleven years on the air, the gang at "Cheers" became like family to many fans, ensuring many more years in syndication.

*Wendt v. Host Int'l, Inc.*, 197 F.3d 1284, 1285 (9th Cir. 1999) (Kozinski, J., dissenting) (citing Gebe Martinez, "Cheers" Fans Cry in Their Beers as Sitcom Ends Long Run, L.A. TIMES, May 21, 1993, at B1.).

136. See *Wendt*, 197 F.3d at 1285.

137. See *id.*

played the characters of Norm and Cliff on "Cheers," sued the defendant Host for the use of animatronic robotic figures based upon their physical likenesses in restaurants or bars without their consent.<sup>138</sup> The plaintiffs' claims were grounded upon an allegation of violations of both trademark law and publicity rights.<sup>139</sup> Plaintiffs claimed that when restaurant patrons saw the two animatronic figures named "Bob" and "Hank," the physical likeness of the animatronic figures would be reminders of Wendt and Ratzenberger.<sup>140</sup> The Ninth Circuit permitted plaintiffs to maintain a common law right of publicity claim,<sup>141</sup> as well as a statutory right of publicity claim under the California Civil Code.<sup>142</sup>

Although the court held that an actor does not possess rights to his or her character,<sup>143</sup> the court permitted an actor to claim a violation of the right of publicity if the misappropriation identifies

138. *See id.*

139. *See id.*

140. *See Wendt*, 125 F.3d at 809.

141. *See id.* at 811-12 (analyzing common law right of publicity claim). The court considered the defendants' argument that the plaintiffs should not be allowed to claim appropriation of identity, commonly known as "right of publicity," because the animatronic figures appropriate only the identities of the characters Norm and Cliff, not the identities of Wendt and Ratzenberger, and Paramount owned the copyrights to such characters. *See id.* at 811. In response to this claim, the court reasoned that "[w]hile it is true that appellants' fame arose in large part through their participation in *Cheers*, an actor or actress does not lose the right to control the commercial exploitation of his or her likeness by portraying a fictional character." *Id.* (citing *Lugosi v. Universal Pictures*, 603 P.2d 425, 431 (Cal. 1979)).

142. *See id.* at 810. The court permitted a statutory claim because material facts existed as to the "likeness" of robots to plaintiffs. *See id.* In its analysis of a statutory right of publicity claim, the court concluded from its own inspection of the robots that material facts existed that might cause a reasonable jury to find them sufficiently "like" plaintiffs to violate section 3344 of the California Civil Code. *See id.* California Civil Code § 3344 provides in relevant part:

[a]ny person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner, . . . for purposes of advertising or selling, . . . without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof.

CAL. CIV. CODE § 3344 (West 1997). In response to defendants' claims that plaintiffs' claims are preempted by federal copyright law, the court reasoned as in *Wendt* / that plaintiffs' "claims are not preempted by the federal copyright statute so long as they 'contain elements, such as the invasion of personal rights . . . that are different in kind from copyright infringement.'" *Wendt*, 125 F.3d at 810 (quoting *Wendt v. Host Int'l Inc.*, 1995 WL 11571, at \*1 (9th Cir. Mar. 16, 1995) ("*Wendt I*").

143. *See Wendt*, 125 F.3d at 811. The court noted that the actors did not even attempt to claim that a proprietary interest vests in a character that is associated with the actor. *See id.* The actors argued instead that the animatronic figures, "Bob" and "Hank" were "not related to Paramount's copyright of the creative elements of the characters Norm and Cliff." *Id.*

the actor.<sup>144</sup> The upshot of the *Wendt* court's decision was that it denied the expansion of the right of publicity to include exploitation of characters, and couched right of publicity protection in the determination of whether the appropriated images resembled the actors. The court's failure to expand protection to characters is common to a majority of opinions dealing with right of publicity issues.<sup>145</sup> On balance, courts are hesitant to provide a celebrity with an interest in a character that the celebrity neither owns, nor developed.<sup>146</sup>

#### V. A DEFINITIVE PERSPECTIVE MUST BE FOLLOWED: THE NEED FOR A FEDERAL STATUTE

Over twenty-seven states currently recognize the right of publicity.<sup>147</sup> Although these states have enacted statutes that recognize this right,<sup>148</sup> others rely on common law for protection of their individual rights.<sup>149</sup> States that do not explicitly recognize a right of publicity find justification for protection under privacy law.<sup>150</sup>

Circuit courts remain split over right of publicity issues under varying schemes involving state statutes, common law, privacy based

144. *See id.* The court further explained that an actor's portrayal of a character does not negate the ability to control exploitation of his or her own image despite the fact that the actor cannot have a property interest in his or her character. *See id.*

145. *See, e.g.,* *Cardtoons, L.C. v. Major League Baseball Ass'n*, 95 F.3d 959, 976 (10th Cir. 1996) (deciding First Amendment rights outweigh right of publicity).

146. *See, e.g., Wendt*, 125 F.3d at 811.

147. *See* CAL. CIV. CODE § 3344 (West 1997) (recognizing right of publicity). At least twenty-seven states recognize right of publicity. *See* MCCARTHY, *supra* note 65, § 6.2, at 6-6. States that have recognized the right of publicity under common law include: Connecticut, Georgia, Hawaii, Illinois, Michigan, Minnesota, Missouri, New Jersey, Ohio, and Pennsylvania (California, Florida, Texas, Utah and Wisconsin recognize the right of publicity under statutory law). *See id.* § 6.1, at 6-7 to 6-8; *see also* Lisa M. Ferri & Robert G. Gibbons, Outside Counsel, *Skirting the Right of Publicity in the Wake of "Hoffman v. Capital Cities,"* 221 N.Y. L.J. 8, 8 n.17 (Feb. 26, 1999) (stating over half of all states recognize right by statute of common law). *See generally* Haines, *supra* note 116, at 215-25 (evaluating current right of publicity statutes).

148. For examples of such statutes, *see supra* note 147 and accompanying text.

149. *See Allison v. Vintage Sports Plaques*, 136 F.3d 1443, 1447 (11th Cir. 1998) ("We read Alabama's commercial appropriation privacy right . . . to represent the same interests and address the same harms as does the right of publicity as customarily defined."). *See also* MCCARTHY, *supra* note 65, § 6.1, at 6-7 to 6-8 (listing states with common law right).

150. *See, e.g.,* MASS. GEN. LAWS ANN. ch. 214, § 3A (West 1989); N.Y. CIV. RIGHTS LAW, §§ 50-51 (McKinney 1992); OKLA. STAT. ANN. tit. 21, §§ 839.1-839.3 (West 1983); TENN. CODE ANN. §§ 47-25-1101 to 1108 (2001); VA. CODE ANN. §§ 8.01-40 (Michie 2000); WIS. STAT. ANN. § 895.50 (West 1997).

statutes, and no statute at all. Most prominently, four cases illustrate the unresolved conflicts that are the upshot of a lack of a definitive perspective.

In *Cheatham v. Paisano Publications, Inc.*<sup>151</sup> for example, the Kentucky district court judge permitted an assertion of a right of privacy action based on an appropriation of the "likeness" of Cynthia Cheatham's derriere photographed and subsequently published in a magazine and printed on t-shirts without her permission.<sup>152</sup> In so ruling, the court cited *Waits v. Frito-Lay, Inc.*,<sup>153</sup> which awarded damages to recognized recording artist, Tom Waits, for a violation of California's voice misappropriation statute because Frito-Lay utilized a vocalist in an advertisement that sounded like Waits without his consent.<sup>154</sup> The jury award of \$200,000 compensated for injury to Waits' peace, happiness and feelings to stand in a case primarily involving unauthorized commercial exploitation of a celebrity's vocal identity.<sup>155</sup> In citing the Ninth Circuit, however, the Kentucky court's decision marks the confusion arising from a lack of a definitive perspective dating back to *Haelan* by holding that the plaintiff would have a cause of action only if the distinctive fishnet design of her jeans was recognized by friends and customers.<sup>156</sup>

Under a dual common law and statutory schema, the Ninth Circuit's decision in *Wendt* discussed in the previous section broad-

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151. 891 F. Supp. 381 (W.D. Ky. 1995).

152. See *id.* at 387. It is notable that Kentucky only recognizes the common law right of publicity as an offshoot of privacy rights. See *id.* at 384-85.

153. 978 F.2d 1093 (9th Cir. 1992).

154. See *Cheatham*, 891 F. Supp. at 387 (citing *Waits*, 978 F.2d at 1098, 1101-06).

155. See *Waits*, 978 F.2d at 1111-12. See also Robinson, *supra* note 43, at 199 n.120 (1990). Robinson states that *Waits* underscored two major problems with the state law right of publicity system:

- (1) In a venue well versed on publicity rights, the Ninth Circuit tied the right of publicity to emotional distress. Though emotional distress was not a prerequisite for bringing the action, its presence in the damage award only serves to further widespread confusion about the role of publicity rights. This confusion seems to have affected the jury, which awarded Waits twice as much for psychic injury as it awarded him for the fair market value of his professional services.
- (2) While Waits recouped attorney's fees under the Lanham Act, he could not have recouped the fees on a state action for voice appropriation alone. Waits had to piggy-back his state publicity rights claim onto the federal claim in order to be reimbursed for attorney's fees. These problems, among others, point to the need for a uniform federal statute.

*Id.*

156. See *Cheatham*, 891 F. Supp. at 387.

ened the scope of California's right of publicity law in the context of animatronic reproductions of celebrity likeness.<sup>157</sup> In contrast, under a New York privacy statute, which does not recognize a common law right of publicity, the Southern District of New York rejected plaintiff Astrud Gilberto's request for a right of privacy action based on defendant's unauthorized use of her voice in an advertisement.<sup>158</sup> Specifically, the Frito-Lay advertisement portrayed "Miss Piggy" lip-synching Gilberto's recording of "The Girl From Ipanema," while gorging her face with potato chips.<sup>159</sup> Due to the absence of a common law right of publicity recognition in New York, the plaintiff was forced to bring what amounted to a right of publicity claim under privacy statutes.<sup>160</sup> Ultimately, the plaintiff's claim was dismissed because New York law specifically excludes voice misappropriation under their current statutory scheme.<sup>161</sup>

A case from the Eastern District of Louisiana further illustrates the ongoing conflict perpetuated as a result of a lack of a single standard of examination. In *Prudhomme v. Proctor & Gamble Co.*,<sup>162</sup> for example, the court denied plaintiff Paul Prudhomme's action alleging a violation of his common law privacy and publicity rights and effectively, determined that although Louisiana had no right of publicity statute or common law right of publicity, plaintiff had made a good faith argument for the extension of the common law publicity rights doctrine in Louisiana.<sup>163</sup>

These conflicting circuit court decisions highlight the potentially endless cycle of inconsistency in right of publicity cases that seek the guidance of a federal statute. Not only will the inculcation of a federal statute solve copyright-based preemption questions and assist in the resolution of First Amendment preemption concerns, it will also promote consistency and predictability of protection.

In the interest of creating uniformity among court decisions, Congress should enact a federal statute dealing explicitly with the right of publicity. Celebrities' livelihood is dependent upon the

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157. See *Wendt v. Host Int'l, Inc.*, 125 F.3d 806, 811 (9th Cir. 1997).

158. See *Oliveira v. Frito-Lay, Inc.*, 43 U.S.P.Q.2d (BNA) 1455, 1460 (S.D.N.Y. 1997).

159. See *id.* at 1457.

160. See *id.* (noting plaintiff's claim for violation of publicity under N.Y. Crv. RIGHTS LAW §§ 50, 51 (McKinney 1997)).

161. See *id.* at 1462. Despite the fact that New York Civil Rights Law section 51 was amended to include the unauthorized use of a person's voice in November of 1996, the court dismissed the claim under the statute. See *id.*

162. 800 F. Supp. 390 (E.D. La. 1992).

163. See *id.* at 395-96.

protection of their public persona.<sup>164</sup> Moreover, the morass of laws upon which one may seek protection may encourage practices such as forum shopping<sup>165</sup> and waste of public and judicial resources.<sup>166</sup> Without a workable federal statute that accounts for the ephemeral, chameleon, and continually evolving nature of the technological universe, ongoing confusion among the courts is rendered inevitable.

## VI. CONCLUSION

There has been a plethora of criticism on the scope of the publicity right in the United States.<sup>167</sup> The lack of a judicially manageable standard from which consistent application of the right of publicity can take place proposes entry into dangerous territory.<sup>168</sup> The exigency of developing a comprehensive and predictable approach to celebrity rights is signaled by the rapid permeation of intellectual property concerns within the United States – a prime importer and exporter of celebrity status. Not only is a precisely defined right of publicity stance necessary in the interest of efficacious application within the courts, it is also in the interest of the United States competing in global markets. Public access to popular culture must be defined so as to avoid infringement upon and preemption of creativity in commercial transactions involving celebrities, advertisers and the entertainment industry in general.

The *Wendt* decision represents the nebulous and precarious position of celebrity rights because every analysis for the right of

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164. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 576 (1977) (discussing entertainer's livelihood as deriving from activity giving entertainer reputation). For a further discussion of the economic value of a celebrity's identity, see *supra* notes 28-31 and accompanying text.

165. See Robinson, *supra* note 43, at 201-02 (addressing issue of forum shopping as potential aberration lack of statute may engender).

166. See *id.* at 201-02 (explaining one commentator's argument that "[a] federal right of public identity statute would benefit the public, the judiciary and those who invest time, effort, and money in their personal identities"); Hetherington, *supra* note 4, at 3 ("A sharply defined right of publicity would provide needed certainty in legitimate commercial transactions involving celebrities, advertisers and entertainment concerns while helping guard against overreaching that would unduly restrict public access to and enjoyment of our popular culture.").

167. For a brief discussion of criticism of right of publicity protection, see *supra* note 8 and accompanying text.

168. See, e.g., *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 569-79 (1977) (addressing right of publicity though not comprehensively analyzing right); Burnett, *supra* note 6, at 181-82 (noting difference in application of right of publicity); Gary M. Ropski & Diane L. Marschang, *The Stars' Wars: Names, Pictures and Lookalikes*, 17 AIPLA Q.J. 81, 83 (1989) (addressing various statutes and common law approaches).

publicity finds its exegesis in the sole discretion of the court.<sup>169</sup> In addition to the accoutrements of other intellectual property concerns, the court must determine who is a celebrity,<sup>170</sup> what test should be applied and whether First Amendment concerns<sup>171</sup> override Fair Use Doctrine considerations.<sup>172</sup> Furthermore, the court must assess three issues in every right of publicity action: the status of the plaintiff as a celebrity, public figure or private citizen; the nature of the alleged infringing depiction of that person, news, entertainment, art object, advertisement or product; and the motive of the defendant in so portraying the celebrity. Flaws in the schizophrenic application of publicity protection illuminate a source of continual confusion among the courts presaging the ultimate recognition for a comprehensive and precisely tailored model.<sup>173</sup>

The lack of a bright line rule leaves a significant challenge for the courts.<sup>174</sup> Interestingly enough, judges have neither made substantial efforts to address this concern nor complained over a lack of guidance in their analysis of cases dealing with celebrity rights. Thus, courts wield tremendous flexibility in the aggregate assessment of whether or not to afford protection, with earlier decisions providing little guidance for predicting later ones.<sup>175</sup> Notwithstanding a court's evaluation, the weighing of a bundle of discrete factors

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169. For a further discussion of the *Wendt* decision, see *supra* notes 132-46 and accompanying text.

170. For a further discussion of what defines a celebrity, see *supra* notes 24-27 and accompanying text.

171. For a further discussion of First Amendment concerns, see *supra* notes 115-31 and accompanying text.

172. See Frank, *supra* note 67, at 1141 (suggesting that "the courts would do well to limit the scope of the right of publicity and temper it in a direction more amenable to the First Amendment."). Certainly, a federal statute is necessary to limit the impermissible infringement upon areas constitutionally protected by the First Amendment. See *id.* at 1115 ("[S]erious efforts must be made to limit the encroachment of this personal property right upon First Amendment rights of free expression.").

173. See Robinson, *supra* note 43, at 201-02. Robinson argues that "[a] federal right of public identity statute would benefit the public, the judiciary, and those who invest time, effort, and money in their personal identities." *Id.* Such a call for a standardized right of publicity has been made by numerous commentators. See, e.g., Stephen M. Lobbin, *The Right(s) of Publicity in California: Is Three Really Greater Than One?*, 2 UCLA ENT. L. REV. 157, 193 (1995). Lobbin stated:

[T]he right of publicity should be brought under one definition—it should be one right. And although the legislature has caused much of the present discontinuity, a legislative solution seems more appropriate than a judicial one.

*Id.*

174. For a further discussion of the divergence creating conflict among judicial decisions, see *supra* notes 151-63 and accompanying text.

175. For a further discussion of these decisions, see *supra* notes 151-63.



deemed to be relevant is not likely to lead to convincing or consistent outcomes.<sup>176</sup>

With the upsurge of cases arising in the burgeoning field of celebrity rights,<sup>177</sup> creating a bright line rule for courts to apply is not only warranted, but becomes a necessity to maintain and ensure judicial integrity – the upshot being the consistency and steadfastness of the law.<sup>178</sup> Due to the fact that celebrities seek to use various methods of interpretation including either state right of privacy statutes, state right of publicity statutes, common law, or no law at all, there is an increased chance of confusion among the courts.<sup>179</sup> Though a plaintiff may prove victorious in California in a voice imitation case, the same plaintiff may lose in New York.<sup>180</sup> Consequently, this encourages practices such as forum shopping.<sup>181</sup>

Furthermore, the potential shift in focus toward the direct commercial exploitation of identity relegates the nonpecuniary concern of protecting identity to mere narrative.<sup>182</sup> Such a shift begs the question - what is the real issue of right of publicity protection? Is the crux of right of publicity concerns to promote the economic incentives for producing original and creative works,<sup>183</sup> or does it find its origins in the nonpecuniary concerns such as privacy, reputation, personal autonomy and the “inherent right of

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176. For a further discussion of divergent judicial decisions likely leading to inconsistent outcomes, see *supra* notes 151-66 and accompanying text.

177. For examples of cases arising out of right of publicity claims, see *supra* notes 132-46, 151-63 and accompanying text.

178. For a further discussion of the need for a standardized right of publicity, see *supra* notes 147-66 and accompanying text.

179. See Ropski & Marschang, *supra* note 168, at 99 (noting many variations of laws under which celebrities will seek protection due to undefined nature of right of publicity).

180. See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1112 (9th Cir. 1992) (permitting voice misappropriation claim); *Oliveira v. Frito-Lay, Inc.*, 43 U.S.P.Q.2d (BNA) 1455, 1462 (S.D.N.Y. 1997) (rejecting voice misappropriation claim).

181. See Robinson, *supra* note 43, at 201 (addressing whether jurisdiction recognizing right of publicity encourages forum shopping while discouraging litigation in another jurisdiction not recognizing such right).

182. See generally Haines, *supra* note 116, at 214-15. Haines discusses the policy arguments as follows:

The right of publicity (1) recognizes the economic value of one's identity; (2) acts as an incentive to creativity by encouraging the production of entertaining and intellectual works; and (3) prevents the unjust enrichment of those who usurp the identity of another.

*Id.* (Footnotes omitted); see also Lobbin, *supra* note 173, at 174 (“There have been several policy arguments consistently set forth by both courts and commentators in favor of the right of publicity—namely, moral, economic, distributional, and consumer protection justifications for recognizing the right.”).

183. For a further discussion of the purpose of Federal Copyright Law, see *supra* notes 81-114 and accompanying text.

every human being to control the commercial use of his or her identity?"<sup>184</sup> Whether these questions will remain rhetorical ones depends largely upon the courts and without further inquiry into the original purpose of offering right of publicity protection, confusion will be compounded and inconsistencies will abound.

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184. McCarthy, *supra* note 23, at 1704; Lobbin, *supra* note 173, at 158 (noting "the individual's commercial interest in persona . . . [is] consistently labeled the 'right of publicity'"); see also MCCARTHY, *supra* note 65, § 1.1, at 1-2 (defining right of publicity as right to control commercial aspects of identity).

